

## **REMARKS**

### **Introduction**

Applicants note with appreciation the Examiner's indication that each of the references cited in the Information Disclosure Statement of October 27, 2005, have been considered.

Upon entry of the foregoing amendment, claims 1-34 and 36-41 are pending in the application. Claims 8, 14, 19, 25, 33, 39 have been amended, claim 35 has been cancelled, and claim 41 has been added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

### **1. Rejection under 35 USC §102(e): Chen:**

Claims 1-5, 7-15, 17, and 25-31 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,019,869 to Chen. Applicants respectfully request reconsideration and withdrawal of this rejection for at least the following reasons.

#### **a. Claim 1:**

With respect to claim 1, on page 2 of the Office Action of September 10, 2007 (hereinafter the "Office Action"), the Examiner alleges that all of the limitations of the invention as recited in this claim are disclosed by Chen. In particular, the Examiner alleges that:

Chen discloses a scanning and/or printing apparatus (Fig. 4), comprising: a scanning unit scanning a document and outputting a scanned result (Column 5 Lines 63-67 Fig. 1 Element 110); a storage unit inherently shows storing the scanned result inputted from the scanning unit (Fig. 4 Element 481); and a printing unit reading the scanned result from the storage unit to print the scanned result (Column 6, Lines 34-45) and (Column 5, Lines 37-45), wherein the storage unit is selectively connected to one of the scanning unit and the printing unit. (Column 6, Lines 34-50).

However, the Applicants respectfully submit that Chen does not disclose the invention as recited in this claim, for at least the following reasons.

As illustrated in FIG. 4, Chen describes a paperless fax-scanning apparatus which stores received fax data to a data storage unit. See Chen, Col. 2, lines 30-43. That is, Chen describes how data in a storage unit can be faxed by the paperless fax-scanning apparatus, or faxed data can be stored into the storage unit. See Chen, Col. 6, lines 25-30. However, Chen

does not describe selectively connecting the storage unit to "one of the scanning unit and the printing unit," as recited in claim 1.

Instead, Chen describes that the paperless fax-scanning apparatus can also be connected to an external storage device 481 to externally store the fax/scanned data and a printer 482 to print the fax/scanned data. See Chen, Col. 6, lines 34-50. That is, the fax/scanned data stored in the storage unit can be further sent to the USB device 481 for external storage or to the printer 482 to be printed, but the external storage device 481 is not connected to the printer 482. This is not the same as "wherein the storage unit is selectively connected to one of the scanning unit and the printing unit," as recited in claim 1.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). "The elements must be arranged as required by the claim..." In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Accordingly, since Chen does not teach all of the elements set forth in independent claim 1, this claim is patentably distinguishable over Chen, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

b. Claims 2-5 and 7:

With respect to dependent claims 2-5 and 7, it is respectfully submitted that these claims depends from independent claim 1, which is patentably distinguishable from Chen for at least the reasons provided above. Accordingly, since claims 2-5 and 7 contain each of the features as recited in independent claim 1, dependent claims 2-5 and 7 are also patentably distinguishable from Chen, and withdrawal of this rejection and allowance of these claims are respectfully solicited.

Furthermore, with respect to claim 4, Applicants respectfully submit that Chen does not disclose the particular limitations of the invention as recited in this claim. In particular, Chen does not disclose, among other things, "a key unit generating at least one of a searching signal, a deleting signal, and a selecting signal," and a control that "generates a control signal to control

the display unit to display the scanned result," as recited in claim 4. In fact, on pages 8-9 of the Office Action the Examiner admits that the similar limitations recited in claim 6 are not disclosed by Chen. Accordingly, Applicants respectfully submit that claim 4 is itself patentably distinguishable from Chen, and respectfully requests withdrawal of this rejection and allowance of this claim.

c. Claim 8:

With respect to independent claim 8, it is respectfully submitted that this claim is currently amended to clarify a connection of the storage unit to more clearly distinguish the invention as claimed from the cited documents. None of the references cited by the Examiner discloses, teaches, or suggests all of the limitations presently recited in independent claim 8.

In particular, Chen describes that the paperless fax-scanning apparatus can also be connected to an external storage device 481 to externally store the fax/scanned data and a printer 482 to print the fax/scanned data. See Chen, Col. 6, lines 34-50. That is, the fax/scanned data stored in the storage unit can be further sent to the USB device 481 for external storage or to the printer 482 to be printed, but the external storage device 481 is not connected to the printer 482 and the storage unit 130 does not connect directly to the printer.

Accordingly, Chen does not disclose, among other things, "causing the storage unit to be directly connected to a printing unit reading the scanned result from the storage unit, and printing the scanned result read from the storage unit in the printing unit," as presently recited in claim 8. It is thus respectfully submitted that since Chen does not teach all of the elements set forth in claim 8, as presently recited, this claim is patentably distinguishable from Chen, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

d. Claim 9:

With respect to claim 9, on page 4 of the Office Action the Examiner alleges that all of the limitations of the invention as recited in this claim are disclosed by Chen. In particular, the Examiner alleges that:

Chen discloses a scanning and/or printing (Fig. 4) apparatus, comprising: a scanning and/or printing unit scanning a document and printing the scanned result; and (Fig. 3, Element 311) a plurality of storage units storing the scanned result inputted from the scanning and/or printing unit (Fig. 4, Elements 420, 421,

481), wherein the scanning and/or printing unit prints the scanned result read from the storage units (Column 6 Lines 30-34).

However, the Applicants respectfully submit that Chen does not disclose all of the limitations recited in independent claim 9, for at least the following reasons.

As described above, Chen describes a paperless fax-scanning apparatus which stores received fax data to a data storage unit. See Chen, Col. 2, lines 30-43. However, while Chen describes that the paperless fax-scanning apparatus can also be connected to an external printer 482 to print the fax/scanned data, see Chen, Col. 6, lines 34-50, Chen does not describe an apparatus to both scan a document and to print a document as recited in claim 9.

That is, in Chen a printer has to be externally provided and connected to the paperless fax-scanning apparatus. This is not the same as "a scanning and/or printing unit scanning a document and printing the scanned result," as recited in claim 9. In fact, Chen teaches away from a scanning and printing apparatus by being specifically directed to a paper-less fax-scanning apparatus. That is, Chen is specifically designed to replace a printing output to a paperless system. See Chen, Col. 2, lines 30-40.

Accordingly, since Chen does not disclose all of the limitations recited in this claim, claim 9 is patentably distinguishable from Chen, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

e. Claims 10-12:

With respect to dependent claims 10-12, it is respectfully submitted that these claims depends from independent claim 9, which is patentably distinguishable from Chen for at least the reasons provided above. Accordingly, since claims 10-12 contain each of the features as recited in independent claim 9, dependent claims 10-12 are also patentably distinguishable from Chen.

Additionally, with respect to claim 11, it is respectfully submitted that Chen does not disclose the limitations recited in this claim as the Examiner alleges. Chen describes a USB interface 471 to communicate with an external storage device 481 to externally store fax/scanned data from a data storage unit 130. See Chen, Col. 3, lines 30-55, Col. 6, lines 34-50. However, Chen does not use the USB interface 471 to communicate with the printer and the memory, but instead only to transmit data to the USB device 481. This is not the same as "a

scanning/printing control unit outputting the scanned result to the storage units through the input/output port and corresponding ones of the connectors, and printing the scanned result inputted from the storage units through the input/output port and the corresponding ones of the connectors," as recited in claim 11. Accordingly, claim 11 is itself allowable over Chen, and withdrawal of this rejection and allowance of this claim are respectfully requested.

Furthermore, with respect to claim 12, Applicants respectfully submit that Chen does not disclose the particular limitations of the invention as recited in this claim. In particular, Chen does not disclose, among other things, "a key unit generating at least one of a searching signal, a deleting signal, and a selecting signal," and a control that "generates a control signal to control the display unit to display the scanned result," as recited in claim 12. In fact, on pages 8-9 of the Office Action the Examiner admits that the similar limitations recited in claim 6 are not disclosed by Chen. Accordingly, Applicants respectfully submit that claim 12 is itself patentably distinguishable from Chen, and respectfully requests withdrawal of this rejection and allowance of this claim.

f. Claim 13:

With respect to independent claim 13, on page 6 of the Office Action the Examiner alleges that Chen discloses all of the limitations of the invention as recited in claim 13. However, the Applicants respectfully disagree for at least the following reasons.

As described above, Chen describes a paperless fax-scanning apparatus which stores received fax data to a data storage unit. See Chen, Col. 2, lines 30-43. However, while Chen describes that the paperless fax-scanning apparatus can also be connected to an external printer 482 to print the fax/scanned data, see Chen, Col. 6, lines 34-50, Chen does not describe an apparatus to both scan a document and to print a document as recited in claim 13. That is, in Chen a printer has to be externally provided and connected to the paperless fax-scanning apparatus. This is not the same as "scanning a document in a scanning and/or printing unit" as recited in claim 13. In fact, Chen teaches away from a scanning and printing apparatus by being specifically directed to a paper-less fax-scanning apparatus. That is, Chen is specifically designed to replace a printing output to a paperless system. See Chen, Col. 2, lines 30-40.

Accordingly, since Chen does not disclose all of the limitations recited in this claim, claim 13 is patentably distinguishable from Chen, and withdrawal of this rejection and allowance of

this claim are respectfully solicited.

g. Claim 14:

On page 6 of the Office Action, the Examiner alleges that Chen discloses all of the limitations recited in independent claim 14. For example, the Examiner alleges that Chen discloses "a controller (Fig. 2 Element 240) detecting an attachment state of the external storage unit, and storing the scanned result in at least one of the external storage unit and the internal storage unit according to the detected attachment state of the external storage unit (Column 5 Lines 35-39)." However, it is respectfully submitted that this claim is currently amended to clarify a function of the external storage unit to more clearly distinguish the invention as claimed from the cited documents. None of the references cited by the Examiner discloses, teaches, or suggests all of the limitations presently recited in independent claim 14.

In particular, as described above, Chen describes that the paperless fax-scanning apparatus can also be connected to an external storage device 481 to externally store the fax/scanned data and a printer 482 to print the fax/scanned data. See Chen, Col. 6, lines 34-50. That is, the fax/scanned data stored in the storage unit can be further sent to the USB device 481 for external storage or to the printer 482 to be printed, but the external storage device 481 is not connected to the printer 482 and the storage unit 130 does not connect directly to the printer. Thus, Chen does not disclose, among other things, "a controller detecting an attachment state of the external storage unit, and storing the scanned result in at least one of the external storage unit and the internal storage unit according to the detected attachment state of the external storage unit, wherein the detachable external storage unit is directly connected to a printer to print the scanned result when the scanned result is stored in the external storage," as presently recited in claim 14.

Accordingly, since Chen does not disclose all of the limitations presently recited in this claim, claim 14 is patentably distinguishable from Chen, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

h. Claims 15 and 17:

With respect to dependent claims 15 and 17, it is respectfully submitted that these claims depends from independent claim 14, which is patentably distinguishable from Chen for at

least the reasons provided above. Accordingly, since claims 15 and 17 contain each of the features as presently recited in independent claim 14, dependent claims 15 and 17 are also patentably distinguishable from Chen, and withdrawal of this rejections and allowance of these claims is respectfully requested.

i. Claim 25:

With respect to independent claim 25, Applicants respectfully submit that this claim is currently amended to clarify an operation of a printing unit of the scanning apparatus to more clearly distinguish the invention as claimed from the cited documents. None of the references cited by the Examiner discloses, teaches, or suggests all of the limitations presently recited in independent claim 25.

In particular, as described above, Chen describes that the fax/scanned data is stored in a storage unit and can be further sent to a USB device 481 for external storage or to the printer 482 to be printed, but the external storage device 481 is not connected to the printer 482 and the storage unit 130 does not connect directly to the printer. Thus, Chen does not disclose, among other things, "a storage unit detachably attached to the scanning unit, and storing the scanned result inputted from the scanning unit, wherein a printing unit of the scanning apparatus directly accesses the stored scanned result to print the stored scanned result according to a user request," as presently recited in claim 25.

Accordingly, since Chen does not disclose all of the limitations presently recited in this claim, claim 25 is patentably distinguishable from Chen, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

j. Claims 26-31:

With respect to dependent claims 26-31, it is respectfully submitted that these claims depends from independent claim 25, which is patentably distinguishable from Chen for at least the reasons provided above. Accordingly, since claims 26-31 contain each of the features as presently recited in independent claim 25, dependent claims 26-31 are also patentably distinguishable from Chen, and withdrawal of this rejections and allowance of these claims is respectfully requested.

**2. Rejection under 35 USC §103(a): Chen and Ahne et al.:**

Claims 6 and 39-40 have been rejected under 35 U.S.C. §103(a) as unpatentable over Chen in view of U.S. Patent No. 7,068,387 to Ahne et al. Applicants respectfully request reconsideration and withdrawal of this rejection for at least the following reasons.

a. Claim 6:

With respect to dependent claim 6, it is respectfully submitted that this claim depends from independent claim 1, which is allowable over Chen for at least the reasons provided above. Accordingly, dependent claim 6 is also allowable over Chen. Furthermore, since the Examiner cites Ahne et al. merely to allege it discloses a display and key unit, Ahne et al. does not teach or suggest any of the limitations lacking in Chen. Therefore, claim 6 is allowable over Chen and Ahne et al., either separately or combined, and withdrawal of this rejection and allowance of this claim is respectfully solicited.

b. Claim 39:

On pages 9-10 of the Office Action, the Examiner alleges that Chen in view of Ahne et al. combined disclose all of the limitations recited in independent claim 39. However, the Applicants respectfully submit that claim 39 is currently amended to clarify a structure of the scanning and printing apparatus. As amended, none of the references cited by the Examiner teach or suggest the limitations presently recited in this claim.

In particular, as described above, Chen describes a paperless fax-scanning apparatus which stores received fax data to a data storage unit. See Chen, Col. 2, lines 30-43. However, while Chen describes that the paperless fax-scanning apparatus can also be connected to an external printer 482 to print the fax/scanned data, see Chen, Col. 6, lines 34-50, Chen does not describe an apparatus to both scan a document and to print a document as recited in claim 39. In fact, Chen teaches away from a scanning and printing apparatus by being specifically directed to a paper-less fax-scanning apparatus. That is, Chen is specifically designed to replace a printing output to a paperless system. See Chen, Col. 2, lines 30-40.

Furthermore, since the Examiner cites Ahne et al. merely to allege it discloses a display and key unit, Ahne et al. does not teach or suggest any of the limitations lacking in Chen.



Accordingly, since Chen and Ahne et al., either separately or combined, do not disclose all of the limitations presently recited in claim 39, this claim is allowable over both references, and withdrawal of this rejection and allowance of this claim is respectfully solicited.

c. Claim 40:

With respect to dependent claim 40, it is respectfully submitted that this claim depends from independent claim 39, which is patentably distinguishable from Chen and Ahne et al. for at least the reasons provided above. Accordingly, since claim 40 contains each of the features as presently recited in independent claim 39, dependent claim 40 is also patentably distinguishable from Chen and Ahne et al., either individually or combined, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

**3. Rejection under 35 USC §103(a): Chen and Hayward et al.:**

Claims 16, 18, and 32 have been rejected under 35 U.S.C. §103(a) as unpatentable over Chen in view of U.S. Patent No. 7,111,250 to Hayward et al. Applicants respectfully request reconsideration and withdrawal of this rejection for at least the following reasons.

a. Claim 16:

With respect to claim 16, Applicants respectfully submit that this claim is allowable for at least the reason of its dependency. Further, Applicants respectfully submit that Chen is not combinable with Hayward et al. in the manner alleges by the Examiner, for at least the reason that Chen specifically teaches away from including a printing unit in the paperless fax-scanning unit described in Chen. That is, Chen is directed to a paperless apparatus to replace a printing output of a conventional fax apparatus. See Chen, Col. 2, lines 30-40.

b. Claim 18:

With respect to claim 18, while on pages 10-11 of the Office Action the Examiner admits that Chen does not disclose the second interface unit as recited in this claim, the Examiner alleges that "Hayward (Fig. 1 Element 26) discloses a second interface unit...", and that "it would be obvious... ..to modify Chen's scanning unit with Hayward's second interface to be able to control data coming in from outside of the scanning unit."

However, contrary to the Examiner's allegations Hayward et al. does not disclose the second interface as recited in claim 18. Instead, Hayward et al. describes "a user interface (IU) 26" through which a user enters commands. See Hayward et al., Col 3, lines 40-45. That is, Hayward et al. describes that the user interface 26 can be used to operate the image transfer device 12 for various house-keeping functions or to activate various command buttons 52. See Hayward et al., Col. 5, lines 66-67, Col. 6, lines 1-23. This is not the same as "a second interface unit , wherein the controller receives the scanned result from an outside of the scanning apparatus through the first interface unit, and outputs the scanned result inputted from the outside of the scanning apparatus through the first interface unit to the outside of the apparatus through the second interface unit, and the scanned result to be outputted to the outside of the scanning apparatus through the second interface unit is printed," as recited in claim 18.

Accordingly, Applicants respectfully submit that since neither Chen nor Hayward et al., either separately or combined, teach or suggest the limitations recited in this claim, claim 18 is allowable over both references, and withdrawal of this rejection and allowance of this claim are respectfully solicited.

c. Claim 32:

With respect to dependent claim 32, it is respectfully submitted that this claim depends from independent claim 25, which is allowable over Chen for at least the reasons provided above. Accordingly, dependent claim 32 is also allowable over Chen. Furthermore, since the Examiner cites Hayward et al. merely to allege it discloses a first and second sub-storage units, Hayward et al. does not teach or suggest any of the limitations lacking in Chen. Therefore, claim 32 is allowable over Chen and Hayward et al., either separately or combined, and withdrawal of this rejection and allowance of this claim is respectfully solicited.

**4. Rejection under 35 USC §103(a): Hayward et al. and Chen:**

Claims 19-24 have been rejected under 35 U.S.C. §103(a) as unpatentable over Hayward et al. in view of Chen. Applicants respectfully request reconsideration and withdrawal of this rejection for at least the following reasons.

a. Claim 19:

With respect to independent claim 19, it is respectfully submitted that this claim is currently amended to clarify an operation of the scanning apparatus to more clearly distinguish the invention as claimed from the cited documents. None of the references cited by the Examiner discloses, teaches, or suggests all of the limitations presently recited in independent claim 19. For example, since Chen specifically teaches away from including a printing unit in the paperless fax-scanning unit, that is, since Chen is directed to a paperless apparatus to replace a printing output of a conventional fax apparatus, see Chen, Col. 2, lines 30-40, Chen is not combinable with Hayward et al. to teach or suggest the method of a scanning apparatus recited in claim 19.

Accordingly Applicants respectfully submit that claim 19 is allowable over Hayward et al. and Chen, and respectfully request withdrawal of this rejection and allowance of this claim.

b. Claims 20-24:

With respect to dependent claims 20-24, it is respectfully submitted that these claims depend from independent claim 19, which is allowable over Hayward et al. and Chen for at least the reasons provided above. Accordingly, dependent claims 20-24 are also allowable over these references, and withdrawal of this rejection and allowance of this claim is respectfully solicited.

**5. Rejection under 35 USC §103(a): Ahne et al. and Hayward et al.:**

Claims 33-38 have been rejected under 35 U.S.C. §103(a) as unpatentable over Ahne et al. in view of Hayward et al. Applicants respectfully request reconsideration and withdrawal of this rejection for at least the following reasons.

a. Claim 33:

With respect to independent claim 33, it is respectfully submitted that this claim is currently amended to clarify an operation of the printing unit to more clearly distinguish the invention as claimed from the cited documents. None of the references cited by the Examiner discloses, teaches, or suggests all of the limitations presently recited in independent claim 33.

In particular, it is respectfully submitted that Hayward et al. specifically teaches away from the invention recited in this claim. That is, Hayward et al. describes an image transfer system comprising an image transfer device operably connected to a computer. See Hayward et al., Col. 1, lines 5-9. This is not the same as, "wherein the printing unit prints the scanned result read from the storage unit and the storage unit is not connected through a processing unit disposed outside of the printing apparatus," as recited in claim 33, and thus, Hayward et al. is not combinable with Ahne et al. to teach or suggest the limitations recited in this claim.

b. Claims 34 and 36-38:

With respect to dependent claims 34 and 36-38, it is respectfully submitted that these claims depend from independent claim 33, which is allowable over Ahne et al. and Hayward et al. for at least the reasons provided above. Accordingly, dependent claims 34 and 36-38 are also allowable over these references, and withdrawal of this rejection and allowance of these claims is respectfully solicited.

c. Claim 35:

With respect to claim 35, it is respectfully submitted that this claim is cancelled, rendering this rejection moot.

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Reply to the Office Action of September 10, 2007

**Conclusion**

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

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Dated: January 9, 2008

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